



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/095,478	06/10/1998	PLOWMAN GREGORY D.	235/054	9689

7590

12/15/2004

Beth A. Burrous
Foley & Lardner Washington Harbour
3000 K Street N.W., Suite 500
Washington, DC 20007-5143

EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/095,478

Applicant(s)

GREGORY D. ET AL.

Examiner

Karen A Canella

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 35 and 36 have been canceled. Claim 37 has been amended. Claims 38-41 have been added. Claims 37-41 are pending and under consideration.

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 37-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Without a qualifier such as "isolated" or "purified" the claimed polypeptides encompass those found in nature.

4. Claims 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahmad et al (Journal of Clinical Investigation, 1995, Vol. 85, pp. 2806-2812, cited in the previous Office action).

Claim 36 is drawn in part to a polypeptide comprising (c)amino acid residues of 188-420 of SEQ ID NO:5, residues 225-457 of SEQ ID NO:6 or residues 188-405 of SEQ ID NO:7 wherein said polypeptide has tyrosine phosphatase activity. Claim 41 is drawn to a polypeptide comprising residues of 188-420 of SEQ ID NO:5, residues 225-457 of SEQ ID NO:6 or residues 188-405 of SEQ ID NO:7 wherein said polypeptide has tyrosine phosphatase activity.

Ahmend et al disclose the preparation of human adipose tissue homogenates and the compartmentalization of the PTP enzymes from the adipose tissue into an infranate by centrifugation. The polypeptides of 36(c) and claim 41 would inherently be enriched in said infranate.

Applicant argues that because the reference does not disclose the amino acid sequences the claims are not anticipated (top of page 7). This has been considered but not found persuasive. The instant claims are drawn to polypeptides. The instant claims fail to exclude polypeptide found in nature because they lack a qualifier such as "isolated" or "purified". The polypeptides found in nature by Ahmend et al would inherently comprise the instant

Art Unit: 1642

polypeptides because the nucleic acids encoding the instant polypeptides were isolated from murine fat cells. Thus, the corresponding human PTP polypeptides would comprise the amino acids constituting the tyrosine phosphatase active site.

5. Amendment of the claims to recite "isolated polypeptide" would overcome the instant rejections.

6. All other rejections and objections as set for or maintained in the previous Office action are withdrawn in light of applicant's amendments.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen A Canella whose telephone number is (571)272-0828. The examiner can normally be reached on 10 a.m. to 9 p.m. M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on (571)272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karen A. Canella, Ph.D.

12/13/2004

Karen A. Canella
KAREN A. CANELLA PH.D.
PRIMARY EXAMINER